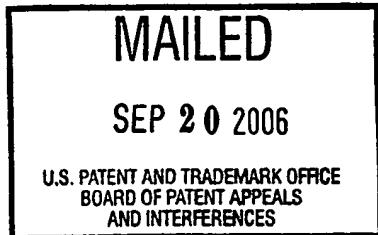


The opinion in support of the decision being entered today was *not* written for publication in and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICARDO GUIMARAES and ROD ROSS



Appeal No. 2006-1935
Application No. 09/726,953
Technology Center 3700

ON BRIEF

Decided: September 20, 2006

Before FRANKFORT, OWENS, and FETTING, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in this application.

We AFFIRM IN PART.

BACKGROUND

The appellants' invention relates to a system and method for performing an ophthalmic procedure. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A system used to perform an ophthalmic procedure on a cornea of a patient, comprising:

a patient support that can support the patient;

a light source that can direct a light beam onto the cornea of the patient; and,

an air flow module that can direct a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air.

PRIOR ART

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kawesch	6,019,754	February 1, 2000
Glockler	6,251,101	June 26, 2001 (June 26, 1998)

REJECTIONS

Claims 12 through 14 stand rejected under 35 U.S.C. § 102(e) as anticipated by Kawesch.

Claims 1 through 11 stand rejected under 35 U.S.C. § 103 as obvious over Kawesch in view of Glockler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (mailed July 28, 2005) for the reasoning in support of the rejection, and to appellants' brief (filed April 13, 2005) and reply brief (filed October 3, 2005) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations that follow.

Claims 1 through 11 rejected under 35 U.S.C. § 103 as obvious over Kawesch in view of Glockler.

We note that the appellants have elected to argue claims 1 through 11 as a group. Therefore we select claim 1 as a representative claim.

The appellants argue that Kawasch's system is especially made to dehydrate the corneal flap in contrast with the claim limitation that "the cornea is not dehydrated by the flow of air." [See Brief, p. 4-5]. The appellants further argue that Kawasch's fig. 4 shows that the flow of air would directly impinge and thus dehydrate the cornea in contrast with the claimed "flow of air above the cornea of the patient from one side of the cornea to another side of the cornea." [See Brief, p. 6].

The examiner responds that the air flow module of claim 1 has a structure that "can direct a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air." The examiner argues that so long as the structure is capable of achieving this result, the claim limitation is met,

particularly given the use of the word “can” denoting capacity as contrasted with performance. The examiner then argues that Kawasch’s system is capable of having the air directed to achieve this result and that the direction of the flow in Kawasch’s system would still be from one side to the other, irrespective of whether the flow impinged on the cornea. [See Answer p. 5-6]. The examiner further argues that Kawasch teaches that the air flow dries the corneal gutter area rather than the entire corneal area. [See Answer p. 6].

We note that Kawasch fig. 4 shows the air flow device in a position that would direct air flow from one side of the cornea to the other. The device producing the air flow is to one side of the patient, and is not aimed so directly at the patient that the flow across the patient would be blocked. We further note that the claim makes no mention of whether the air flow impinges on the cornea. We note that the Kawasch patent describes drying the corneal gutter area, which is the perimeter of a flap that has been cut in the cornea, until the gutter area is substantially dry, and this typically takes 15 to 30 seconds. [See Kawasch col. 5 lines 38 to 55]. From this we note that the examiner’s argument is correct that Kawasch describes drying the corneal flap rather than the entire cornea and we further note that the time constraint taught by Kawasch implies that operating the air flow less than 15 seconds would not dehydrate even the corneal flap, much less the entire cornea.

As the examiner noted, an apparatus claim is defined by its structure, not its method of use. We note that, as the examiner argues, the device in Kawasch “can direct a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air.” Therefore, we find the appellants’ arguments to be unpersuasive.

Accordingly, we sustain the examiner's rejection of claims 1 through 11 rejected under 35 U.S.C. § 103 as obvious over Kawesch in view of Glockler.

Claims 12 through 14 rejected under 35 U.S.C. § 102(e) as anticipated by Kawesch.

The appellants originally argued all claims together [See Brief p. 3], but separately argued the method claims 12 through 14 in the reply brief [See Reply Brief p. 2]. The appellants argue

that Kawasch, insofar as it applies to a method claim, uses its device to dehydrate the cornea, and there is no suggestion to use it so as to not dehydrate the cornea. The appellants further distinguish these claims from the apparatus claims in that structural capacity is not an issue in these claims, which was a determinative issue in the apparatus claims above. We note that Kawasch does indeed describe the process it uses as ultimately dehydrating the corneal flap. The examiner made no rebuttal to this new separate argument to claims 12 through 14. Therefore, we find the appellant's arguments to be persuasive.

Accordingly we do not sustain the examiner's rejection of claims 12 through 14 rejected under 35 U.S.C. § 102(e) as anticipated by Kawesch.

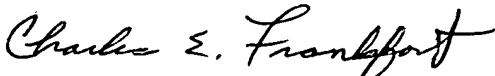
CONCLUSION

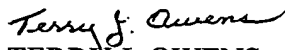
To summarize,

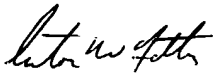
- The rejection of claims 1 through 11 rejected under 35 U.S.C. § 103 as obvious over Kawesch in view of Glockler is sustained.
- The rejection of claims 12 through 14 rejected under 35 U.S.C. § 102(e) as anticipated by Kawesch is not sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED IN PART


CHARLES E. FRANKFORT
Administrative Patent Judge


TERRY J. OWENS
Administrative Patent Judge


ANTON W. FETTING
Administrative Patent Judge

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